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MAY 14 2003

OFFICE OF PETITIONS

In re Application of	:	
Burt Swersey, Marcie J. Harvey, Elias	:	
Kaplan, Jennifer Lamana, Stephen J.	:	
Howard, Dean Meloney, John Weed, and	:	SECOND RENEWED DECISION
Timothy Novak	:	REFUSING STATUS UNDER
Application No. 09/800,872	:	37 CFR §1.47(a)
Filed: March 7, 2001	:	
Title: DIFFERENTIAL PERMEOMETER	:	

This is in response to the second renewed petition under 37 CFR §1.47(a)¹, filed May 8, 2001.

The second renewed petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Second Renewed Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 C.F.R. §1.136(a).

¹ A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
- (5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
- (6) a declaration which complies with 37 CFR 1.63.

The above-identified application was filed on March 7, 2001. On April 18, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), requiring an executed oath or declaration in compliance with 37 CFR §1.63 and the surcharge for its late filing. This Notice set a two-month period for reply.

The original petition, filed on September 10, 2001, was dismissed in a decision mailed on March 15, 2002, for failure to prove that diligent efforts have been made to locate the non-signing inventor.

With the renewed petition, a fully executed declaration was filed. It was then noticed by the undersigned that the declaration filed with the original petition contains a non-initialed, non-dated change on the residence line of inventor Weed. The undersigned then cited to 37 C.F.R. 1.52(c).

Petitioner was instructed to submit upon second renewed petition a newly executed declaration, signed by inventor Weed, with either the correct address listed, or the change both initialed and dated.

With the second renewed petition, the petitioner makes the following three arguments:

1. 37 C.F.R. §1.52(c) does not refer to alterations made in the declaration, but rather those made to the application papers.
2. 37 C.F.R. §1.52(c) does not require that hand-written changes be signed and dated, in that the language of the rule uses the word *should*, and not *must*.
3. 37 C.F.R. §1.52(c) provides that the alterations may be made on the same sheet of paper.
4. The change was made contemporaneously with the signing.

Regarding the first and second arguments above, the undersigned agrees that 37 C.F.R. §1.52(c) refers to the application papers, and uses the word *should*. However, the citation to this rule was a misprint, in that the decision should have cited to MPEP 605.04(a). The Office regrets this error.

Regarding each of these four arguments, MPEP 605.04(a) states that if any changes are made in ink to the oath² and are not signed and initialed, the Office will require a new declaration.

As changes have been made to the declaration which have not been dated and initialed, a new declaration is required. If petitioner cannot locate the non-singing inventor, a petition under 37 C.F.R. §1.183 will be required to waive 37 C.F.R. §1.67.

The reply to this letter may be submitted by mail³, hand-delivery⁴, or facsimile⁵.

² The declaration is not mentioned explicitly, but the words "oath" and "declaration" are used interchangeably throughout the MPEP.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.



Paul Shanowski
Attorney
Office of Petitions
United States Patent and Trademark Office

³ Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1460, Alexandria, VA 22313-1460. Note that this is a new address, as the USPTO has changed addresses as of May 1, 2003.

⁴ Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

⁵ (703) 308-6916, Attn: Office of Petitions.